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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/006,679	12/10/2001	Takeshi Araki	401502	1583		
23548	7590 02/28/2003					
	OIT & MAYER, LTD	EXAMINER				
700 THIRTEENTH.ST. NW SUITE 300			SHEEHAN, JOHN P			
WASHINGTON, DC 20005-3960			ART UNIT	PAPER NUMBER		
			1742			
			DATE MAILED: 02/28/2003	DATE MAILED: 02/28/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

.4-4	Application No.			Applicant(s)	
	10/006,679	i ė	1/	ARAKI ET AL.	
Office Action Summary	Examiner		1	Art Unit	
	John P. Sheehar			1742	
The MAILING DATE of this communication appeariod for Reply	ears on the cov I	sheet with th	COI	rrespondenc ac	iaress
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period we Failure to reply within the set or extended period for reply will, by statute, - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). Status	i6(a). In no event, howe within the statutory mir ill apply and will expire cause the application to	ever, may a reply be imum of thirty (30) o SIX (6) MONTHS fr b become ABANDO	e timely days w rom the ONED	y filed vill be considered time e mailing date of this c (35 U.S.C. § 133).	ly. ommunication.
1) Responsive to communication(s) filed on 26 E	<u> December 2002</u> .				
2a) ☐ This action is FINAL . 2b) ☑ Thi	s action is non-fi	nal.			
3) Since this application is in condition for allowa closed in accordance with the practice under L Disposition of Claims					ne merits is
4) Claim(s) <u>1-3</u> is/are pending in the application.					
4a) Of the above claim(s) 3 is/are withdrawn fro	m consideration	•			
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1 and 2</u> is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election require	ment.			
Application Papers	-				
9) The specification is objected to by the Examiner		- da huabha Fi			
10) ☐ The drawing(s) filed on is/are: a) ☐ accep					
Applicant may not request that any objection to the 11) The proposed drawing correction filed on	- · ·	-			ner .
If approved, corrected drawings are required in rep			pior.	od by the Exami	
12) The oath or declaration is objected to by the Exa					
Priority under 35 U.S.C. §§ 119 and 120					
13)⊠ Acknowledgment is made of a claim for foreign	priority under 35	5 U.S.C. § 119	9(a)-	(d) or (f).	
a)⊠ All b)□ Some * c)□ None of:		· ·	` ,	`, `,	
1. ☐ Certified copies of the priority documents	s have been rece	ived.			
2. Certified copies of the priority documents			ation	n No. <u>09/392,78</u>	<u>7</u> .
Copies of the certified copies of the prior application from the International Bur See the attached detailed Office action for a list of the certified	eau (PCT Rule	I7.2(a)).			Stage
14) Acknowledgment is made of a claim for domestic		•			l application).
a) ☐ The translation of the foreign language pro 15)☐ Acknowledgment is made of a claim for domesti	visional applicati	on has been r	recei	ved.	
Attachment(s)	,,				
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.	4)			PTO-413) Paper No tent Application (PT	

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Araki et al. (Araki, US Patent No. 5,676,998).

Araki teaches a thin film magnet having a composition that overlaps the alloy composition recited in applicants' claims (column 2, lines 47 to 55) and specific example alloys having a composition encompassed by applicants' claims (see Araki's Tables 5 to 7). Araki teaches that the main phase of the alloy is Nd₂Fe₁₄B (column 2, lines 50 to 51). Araki teaches that the C-axis of the alloy film is oriented normal to the film plane (column 6, lines 25 to 27). Araki teaches that the disclosed thin film is made by physical vapor deposition on a substrate while heating the substrate (column 2, lines 60 to 67).

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Araki teaches specific examples wherein the alloy composition and the substrate temperature are encompassed by the substrate temperatures disclosed in the instant application and the alloy composition recited in the instant claims (for example, compare Table 2 of the instant application to the compositions and substrate temperatures in Araki's Table 7).

The claims and the Araki differ, in that Araki is silent with respect to the presence of an amorphous phase, the amorphous phase isolating the Nd₂Fe₁₄B phase and the process limitation that the temperature of the front side of the substrate is controlled within + 2°C.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the specific example alloy compositions taught by Araki are encompassed by the instant claims and are made by the same process, including heating the substrate to the same temperature as disclosed in the instant application and therefore one of ordinary skill in the art would expect that the products taught by Araki would be the same as applicant's claimed product, including the presence of an amorphous phase and the amorphous phase isolating the Nd₂Fe₁₄B phase.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada,15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art

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products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

With respect to the process limitation that the temperature of the front side of the substrate is controlled within ± 2 °C it is the Examiner's position that a process limitation recited in the instant product by process claims does not necessarily lend patentability to the claimed product, MPEP 2113.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

/John P. Sheehan Primary Examiner Art Unit 1742

jps February 25, 2003